APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,203	03/05/2002	Mingchi S. Mak	5681-10700	6376

7590 10/04/2005	**EXAMINER**
Robert C. Kowert	VU, THONG H
Conley, Rose, & Tayon, P.C.	

ART UNIT	PAPER NUMBER
2142	

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DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
	10/091,203	MAK ET AL.
Office Action Summary	Examiner	Art Unit	
	Thong H. Vu	2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 August 2005*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date *8/05*.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

1.   Claims 1-32 are pending.

2.   The co-pending applications are 10/90,893 and 10/091,204.

Response to Arguments

3.   Applicant's arguments with respect to claims 1-32 have been considered but are

moot in view of the new ground(s) of rejection.

Double Patenting

4.   Claims 1-32 of this application conflict with claims 1-38 of Application No.

10/090,893. 37 CFR 1.78(b) provides that when two or more applications filed by the

same applicant contain conflicting claims, elimination of such claims from all but one

application may be required in the absence of good and sufficient reason for their

retention during pendency in more than one application. Applicant is required to either

cancel the conflicting claims from all but one application or maintain a clear line of

demarcation between the applications. See MPEP § 822.

The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees. See In re Goodman, 11
F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225
USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA
1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, In re Thorington,
418 F.2d 528, 163 USPQ 644 (CCPA 1969).
A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to
overcome an actual or provisional rejection based on a nonstatutory double patenting ground
provided the conflicting application or patent is shown to be commonly owned with this
application. See 37 CFR 1.130(b).
Effective January 1, 1994, a registered attorney or agent of record may sign a
terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with
37 CFR 3.73(b).

Claims 1-32 are provisionally rejected under the judicially created doctrine of

double patenting over claims 1-38 of copending Application No. 10/090893. This is a

provisional double patenting rejection since the conflicting claims have not yet been

patented.

The subject matter claimed in the instant application is fully disclosed in the

referenced copending application and would be covered by any patent granted on that

copending application since the referenced copending application and the instant

application are claiming common subject matter, as follows:

('893) Claim1. A system comprising:
        a server comprising a document in a format supported by the server, wherein the
document is available to one or more devices via a network; a small device configured
to couple to the server;
        wherein the server is configured to generate a small device document in a format
supported by the small device from the document in the format supported by the server;
        wherein the small device is further configured to modify the small device
document; and
        wherein the server is further configured to synchronize the document in the
format supported by the server with a modified version of the small device document on
the small device.

('203. Claim 1). A system comprising:
        a server configured to store documents in one or more server formats, wherein
the documents are available to one or more devices via a network, wherein the server is
configured to generate a small device document in a small device format from a
document in a server format, wherein, to generate a small device document in a small
device format from a document in a server format, the server is further configured to
exclude one or more formats for content of the document in the server format from the
small device document; and
        wherein the server is further configured to provide the small device document to
a small device coupled to the server; the small device, wherein the small device is
configured to:
        modify the small device document to produce a modified version of the small
device document; and
        provide the modified version of the small device document to the server; wherein
the server is further configured to generate a modified version of the document in the
server format from the modified version of the small device document, wherein, to

generate a modified version of the document in the server format from the modified version of the small device document, the server is further configured to restore the one or more formats for content of the document in the server format excluded from the small device document.

('203. Claim 7). configured to resolve differences between the modified version of the document in the server format and another modified version of the document in the server format to <u>generate a synchronized version of the document in the server format</u>.

Furthermore, there is no apparent reason why applicant would be prevented from

presenting claims corresponding to those of the instant application in the other

copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA

1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-32 are rejected under 35 U.S.C. 103(a) as obvious over Mendez et al

[Mendez, 5,961,590] in view of Boucher et al [Boucher 6,725,421 B1].

5.   As per claim 1, Mendez discloses A system comprising:

a server configured to store documents in one or more server formats (i.e.: global

format), wherein the documents are available to one or more devices via a network (i.e.:

Internet), wherein the server is configured to generate a small device document in a

client format from a document in a server format [Mendez, the client format A and

server global format, col 4 lines 57- col 5 line 25; PDA, col 5 lines 26-47], wherein, to

generate a client document in a client format from a document in a server format, the

server is further configured to exclude (i.e.: select) one or more formats for content of

the document in the server format from the client document [Mendez, the global server

access or format to the content, col 13 lines 1-15; the email module select and

download client email, col 17 lines 14-34];

An Official Notice is taken that the information relating to the content and /or the

format of the converted text was well-known in the art [see Marmor reference]

wherein the server is further configured to provide the client document to a client

device coupled to the server [Mendez, the client format A and server global format, col 4

lines 57- col 5 line 25; PDA, col 5 lines 26-47];

the client wherein the small device is configured to:

modify the client document to produce a modified version of the client document

[Mendez, modified version, col 6 lines 35-42]; and

provide the modified version of the client document to the server [Mendez,

modified folder, col 8 lines 1-60];

wherein the server is further configured to generate a modified version of the

document in the server format from the modified version of the client document

[Mendez, update version for translation, col 10 lines 25-67], wherein, to generate a

modified version of the document in the server format from the modified version of the

client document [Mendez, modified version, col 6 lines 35-42]:

However Mendez does not explicitly detail "the server is further configured to

restore the one or more formats for content of the document in the server format

excluded from the client document"

In the same endeavor, Boucher discloses a method and apparatus for storing,

retrieving and playing multimedia data [Boucher abstract]; converting data into a format

that can be played [Boucher, col 6 lines 7-14] ; content in XML format can be restored

[Boucher, col 11 lines 19-29; col 21 line 60-col 22 line 6]

Therefore it would have been obvious to an ordinary skill in the art at the time the

invention was made to incorporate the technique of restore the original format as taught

by Boucher into the Mendez's apparatus in order to utilize the modified version process.

Doing so would provide the flexibility to the Web client to select and modify the format

by using any network devices.

6.   As per claim 2, Mendez-Boucher disclose the document in the server format is

an office productivity document [Mendez, email workspace folder, col 8 lines 1-10].

7.   As per claim 3, Mendez-Boucher disclose restore the one or more formats for

content of the document in the server format excluded from the small device document

[Boucher, content in XML format can be restored col 11 lines 19-29; col 21 line 60-col

22 line 6], the server is further configured to:

compare modified content of the modified version of the small device document

to corresponding content of the document in the server format to determine one or more

formats for the modified content of the modified version of the small device document to

be merged with the document in the server format [Mendez, modified version, col 6

lines 35-42; a comparison, col 10 lines 3-17]; and

merge the modified content of the modified version of the small device document

into the document in the server format in accordance with the determined one or more

formats for the modified content [Mendez, merge email, col 2 lines 49-67].

8.   As per claim 4, Mendez-Boucher disclose generate a modified version of the

document in the server format from the modified version of the small device document,

the server is further configured to:

determine differences between the modified version of the small device

document and the document in the server format, wherein each determined difference

indicates changed content of the modified version of the small device document; and for

each of the determined differences, merge corresponding changed content of the

modified version of the small device document with the document in the server format

[Mendez, col 8 lines 27-48]

9.   As per claim 5, Mendez-Boucher disclose determine differences between the

modified version of the small device document and the document in the server format,

the server is further configured to:

generate a modified version of the small device document in the server format

from the modified version of the small device document in the small device format; and

compare the modified version of the small device document in the server format to the

document in the server format [Mendez, modified version, col 6 lines 35-42; a

comparison, col 10 lines 3-17].

10.   As per claim 6, Mendez-Boucher disclose generate a modified version of the

document in the server format from the modified version of the small device document,

the server is further configured to:

        generate a modified document in an interim format from the modified version of

the small device document [Boucher, content in XML format can be restored, col 11

lines 19-29; col 21 line 60-col 22 line 6];

        generate a document in the interim format from the document in the server

format [Mendez, the client format A and server global format, col 5 lines 45-64; col 6

lines 8-63];

        determine one or more differences between the modified document in the interim

format and the document in the interim format [Mendez, determine if any conflicts exist,

col 8 line 35-47];

        for each of the determined differences, merge corresponding changed content of

the modified document in the interim format with the document in the interim format; and

generate the modified version of the document in the server format from the document

in the interim format [Mendez, merge email, col 2 lines 49-67].

11.   As per claim 7, Mendez-Boucher disclose the server is further configured to
resolve differences between the modified version of the document in the server format
and another modified version of the document in the server format to generate a
synchronized version of the document in the server format [Mendez, determine if any
conflicts exist, col 8 line 35-47].

12.   As per claim 8, Mendez-Boucher disclose resolve differences between the
modified version of the document in the server format and another modified version of
the document in the server format, the server is further configured to:

    display the differences between the modified version of the document and the
other modified version of the document; and for each difference, accept user input
specifying which version is to be used in the synchronized version of the document
[Mendez, determine if any conflicts exist, col 8 line 35-47].

13.   As per claim 9, Mendez-Boucher disclose the server comprises a set of policies
configured for use in resolving differences between versions of documents in the server
format, wherein, to resolve differences between the modified version of the document in
the server format and another modified version of the document in the server format,
the server is further configured to, for each difference:

    determine one of the polices corresponding to the difference; and apply the
determined policy to the difference to determine which version is to be used in the
synchronized version of the document [Mendez, determine if any conflicts exist, col 8

line 35-47].

14.   Claims 10-32 contain the similar limitations set for claims 1-9. Therefore claims

10-32 are rejected for the same rationale set forth in claims 1-9.

        Any inquiry concerning this communication or earlier communications from the
examiner should be directed to examiner *Thong Vu*, whose telephone number is (571)-
272-3904. The examiner can normally be reached on Monday-Thursday from 8:00AM-
4:30PM.
        If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, *Andrew Caldwell* can be reached at (571) 272-3868. The fax number for the
organization where this application or proceeding is assigned is 571-273-8300
        Information regarding the status of an application may be obtained from the
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Center (EBC) at 866-217-9197 (toll-free).

Thong Vu
Patent Examiner
Art Unit 2142